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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/002,643	10/31/2001	Hans-Peter Stoll	7163-31	1988

21324 7590 09/28/2004
HAHN LOESER & PARKS, LLP
TWIN OAKS ESTATE
1225 W. MARKET STREET
AKRON, OH 44313

EXAMINER

BOCKELMAN, MARK

ART UNIT PAPER NUMBER

3762

DATE MAILED: 09/28/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/002,643

Applicant(s)

STOLL ET AL.

Examiner

Mark W Bockelman

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 July 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-56 is/are pending in the application.
- 4a) Of the above claim(s) 14-27 and 46-56 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-13 and 28-45 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 31 October 2001 is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 10-31-2001, 6-11-2.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Election/Restrictions

The examiner notes that in the election mailed 6-15-2004 the examiner erred in grouping two of the claims, as noted by applicant in his response of 15 July 2004. Claim 17, which is dependent on claim 16, should have been included in group II rather than group I and claim 27, which is drawn to a combination excitation device and implant should have been classified along with group IV.

Applicant's election with traverse of group I species A claims 1-13, 28-45, in the reply filed on 15 July 2004 is acknowledged. The traversal is on the ground(s) that the examiner did not properly classify the various groupings of claims. This is not found persuasive for several reasons. First, although the examiner misclassified group I, which is a magnetic therapy device and should have been classified in class 600 subclass 9, the remaining classifications are correct. Group I is claiming a magnetic applicator. Group II is claiming a stent alone, which is notably incapable of providing stimulation by itself as disclosed in applicant's specification. Groups III and IV, which recite implantable devices that are used to produce electrical currents, are the only devices that would be classified in class 607 as the claims are currently recited. Statements of intended use are given no weight in classifying claims. Additionally a glance at the classification of art applied to the elected claims in the following office action will demonstrate that stents and electrical stimulator searches were not necessary in providing the art for the rejections applied since the claims are directed to a magnetic excitation device alone that does not include an implant or a stent of

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any sort. Finally, there is no allegation that the inventions are not patentably distinct. The requirement is still deemed proper and is therefore made FINAL.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-8, 10-13, 28-38, 40-45 are rejected under 35 U.S.C. 102(e) as being anticipated by Dissing et al USPN 6,561,968. Dissing et al teaches a device for controlling tissue growth using a plurality of coils for an excitation device. Dissing recognizes the presence and activation of secondary messengers in what he terms as intracellular effects (see column 2 lines 42 to column 3 line 23), which may involve protein kinase as well as interaction with cyclic AMP. Regardless of what Dissing et al considers to be the action, Dissing et al uses the same frequency range as applicant to control tissue growth and therefore the Dissing et al disclosed device possesses all of applicant's claimed structure as well as the inherent function capable of performing applicant's stated

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intended use. Figure 8 shows an alternating current/flux scheme to produce an alternating field. Supporting frame 118 is considered to operate as a positioning device for placing the coil-containing member adjacent to the skin. Applicant's claims 11-13, 41-44 provide statements of intended use which the Dissing device is capable of performing as is any electromagnetic generator depending on how one specifies the hypothetical implant device. The Dissing device includes a timing circuit (column 12 lines 15-38) which produces magnetic field variations over time allowing for different frequencies and amplitudes to be programmed and may produce a magnetic field profile as shown in figure 4b which provide for reduction in intensity in a step wise manner from 0 to 4 cm from the coil center and a continuous reduction from 0 to 2 cm from the center of the coil.

Claims 1-5, 7-13, 28-33, 39-45 are rejected under 35 U.S.C. 102(b) as being anticipated by Kraus et al USPN 3,890,953. Kraus et al teaches applicant's frequency range and thus produces the same results inherently. (see explanation with regard to Dissing et al). In addition, a horseshoe shaped coil is used as can be seen on the front cover of the patent.

Claims 1-8, 10-13, 28-38, 40-45 are rejected under 35 U.S.C. 102(b) as being anticipated by Waltonen et al. USPN 4,674,482. Waltonen is redundant to Dissing et al and Kraus et al in terms of its application to most of the claims with the exception that timing circuits are provided to continuous reduction (fig 3) or stepwise reduction (fig 4) in intensity.

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Claims 1-2,7-8, 10-13, 29, 40-45 are rejected under 35 U.S.C. 102(b) as being anticipated by Liboff et al USPN 5,211,622 or Vona USPN 5,718,246. Both references teach the application of pulses from an excitation device that modify messenger distribution. See Vona for ATP depletion column 4 lines 30+, i.e ADP, AMP increase that deplete synthesis mechanisms and Liboff et al for membrane/ion effects (column 8 line 53 to column 9 line 15).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mark W Bockelman whose telephone number is (703)-308-2112. The examiner can normally be reached on Monday - Thursday 10-8:30.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Angela Sykes can be reached on (703) 308-5181. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

MWB

September 25, 2004


MARK BOCKELMAN
PRIMARY EXAMINER